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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,275	10/13/2005	Christian von Corswant	1103326-0798	6628

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WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

CARR, DEBORAH D

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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07/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,275	Applicant(s) VON CORSWANT ET AL.	
	Examiner DEBORAH D. CARR	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-16 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 2-4, filed 9 April 2008, with respect to the rejection(s) of claim(s) 19-23 under 35 USC § 103(a) have been fully considered and were not persuasive. Therefore, the rejection has been maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen et al.

Applicants argue the starting materials used in the Janssen et al. process are not the same thereby producing different compounds and does not disclose that the hydrolytic enzyme used does not affect any existing ester bond.

The instant process basically reacts a substituted carboxylic acid or ester with a polyoxyalkylene glycol or its lower ester in the presence of a hydrolytic enzyme. The hydrolytic enzyme only catalyzes the ester formation between the carboxylic group of the substituted carboxylic acid or ester and the ending hydroxyl group of the POAG or POAG

lower ester without affecting any preexisting ester or ether bond. The carboxylic acid or ester has been substituted with a hydroxyl group wherein said hydroxyl group has undergone ester or ether derivatization. Therefore, the only reactive sites on the starting compounds are the hydroxyl group of the carboxylic acid and POAG or the alkyloxy group on the carboxylic acid lower ester or POAG lower ester.

Janssen et al. also reacts a carboxylic acid ester with a polyoxyalkylene glycol in the presence of a hydrolytic enzyme. The carboxylic acid used in this process is unsubstituted so the only reactive sites on the starting compounds are the hydroxyl group of the carboxylic acid and POAG.

Both the instant process and the Janssen et al processes utilize the same starting materials (carboxylic acid esters and POAG) having the same reactive sites involved in forming the esterified polyoxyalkylene glycols. As stated in the previous office action, application of an old process to a new and analogous material to obtain a result consistent with teachings of the art would have been obvious to one having ordinary skill.

Once the general reaction has been shown to be old, the burden is on the applicant to present reason or authority for believing that a group of the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or the operability of the process and thus the unobviousness of the method of producing it.

Applicants refer to the hydroxyl group on the instant carboxylic acid that has been esterified or etherized as a means of reinforcing the argument that the same products are not produced. However, these moieties on the carboxylic acid ester are not involved in the reaction mechanism so this argument bears no weight.

While Janssen et al. only used PEG400 as the preferred reactant, it is obvious that PEG as a whole can be used to produce these types of compounds. To choose a PEG of a different weight is considered a design choice based on the type of ester one would be interested in producing and falls into the category of routine experimentation.

As to Janssen et al. not stating the lipase used does not affect the ester and ether bonds already present in the compound, there is no indication that it does affect any ester and ether bonds that may be present in the compound. In analyzing the compounds produced using the lipase, there is no discussion that the ester bonds created were hydrolyzed or the esterification process was reversed while the lipase was present. There is no concern disclosed by Janssen et al. that the use of this hydrolytic enzyme might affect any bond present thereby its use in the process is questionable.

Allowable Subject Matter

4. Claims 1-10, & 13-16 are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH D. CARR whose telephone number is (571)272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ddc

/Deborah D Carr/
Primary Examiner
Art Unit 1621